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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,867	11/30/1998	YUTAKA TAKAMI	HIT2944	2148
24956 7590 08/21/2008 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
EXAMINER GREENE, DANIEL LAWSON				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/201,867

Applicant(s)

TAKAMI ET AL.

Examiner

DANIEL L. GREENE

Art Unit

3694

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/12/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 36, 37, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 23-40 are currently pending with claims 36, 37, 39 and 40 standing withdrawn. The amendment of claims 23 and 27 is acknowledged in the response received 5/12/2008.

Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Amendments and Arguments

2. Applicant's arguments filed 5/12/08 have been fully considered but they are not persuasive.

A. Applicant argues on pages 10-11 of said response:

Claim 23 has been amended to recite that the switching circuit switches between a first path and a second path, the first path connecting a first external device which is enabled to exchange data and control signals through the first path and the public line with the second external device. Claim 23 has also been amended to recite that the control circuit controls the switching circuit to switch to the first path to connect to the first external device when money information and remittance data transferred through the communication circuit with the second external device and the first external device provides the control circuit

with a control signal directing electronic money information transfer on the base of the money information and the remittance data.

Clearly, these features are neither disclosed nor suggested by Jones et al. Jones et al do not disclose or suggest how and when a control circuit controls the switching circuit that connects through the first path to the external device and disconnects the first path to connect to the second path to transfer the money information to or from the IC card.

A. Response:

It appears Applicant has again filed to appreciate the Examiners rejections and explanations set forth in the previous Office actions as Applicant continues to argue the references individually instead of in the manner combined by the Examiner.

Applicant also continues to argue the intended use of a physical structure, e.g.

“...Jones et al do not disclose or suggest **how and when a control circuit controls** the switching circuit...”

“(Emphasis added). Again Per MPEP 2114:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2nd 1525, 1528

Applicant has not set forth any STRUCTURE that patentably distinguishes from the prior art. Again, Applicant may only have the method claims examined by filing an appropriate continuing application

Further, as explained below, a standard modem in the 90's only allowed one thing to talk at a time. When your computer was dialed into the internet you could not pick up a telephone and make a phone call, nor could you speak with the computer. The modem is a switch controlling who talked on what line at what time.

For applicant's convenience, parts of previous Office actions are reproduced below.

From the 5/2/2007 Final Office action:

Regarding claim 23 Jones teaches a terminal device used in an electronic money system comprising a data processor which processes data in an IC card storing electronic money information (col. 2 line 15-45) and a communication circuit which communicates with a second external device through a public line (col. 4 lines 6-12)(Fig 1/5)(col. 5 line 41) a switching circuit which switches between a first path and a second path (col. 5 lines 48-52) said first path outputting data input from a first external device (col. 5 line 49) to said communication circuit and said second path outputting electronic money data from said data processor to said communication circuit(Fig 1/1 b/2b/3b)(col. 4 lines 1-18).

Jones does not appear to explicitly disclose a control circuit, which controls a data processor to switch from a first path to a second path at a time of transaction of electronic money.

Resort may be had to either Griffin (See for example, Figure 1, 2, 3C, Col. 1 lines 33-35, 65+ through col. 2 lines 6, col. 4 lines 18-24, col. 8 lines 20-24, claims 23 and 24, etc.) or Nysen (See for example, Fig 1., col. 2 lines 66 through Col. 3 lines 6, etc.) to teach a control circuit which controls said data processor, said communication circuit, and said switching circuit wherein, said control circuit controls said switching circuit to switch from said first path to said second path wherein it is understood that applicant's claim language can be broken down into more simplified terms such as;

a terminal device = a modem

a data processor = that within Jones Pocket exchange device Figure 6.

a communication circuit = the circuit within the modem

a first communication device = Jones Fig. 1 items 10 and 11, i.e. the vendors terminal

a second external device = Jones computers 1a, 2a, 3a

a switching circuit = the circuit within the modem

a control circuit = the circuit within the modem

Jones sets forth applicant's inventive concept however the claim languages are so convoluted that they obfuscate the invention. Support may be had in reviewing applicant's arguments to the previous rejections of record. That is, that the crux of the invention lies in the smart card NOT communicating with

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the cash register/personal computer/ point of sale (POS) device directly. As applicant argues, this helps to maintain security.

Jones sets forth applicant's invention that is clearly capable of performing the desired or intended use set forth in applicants claim. That is, Applicant's claims are directed towards an apparatus, not a method of performing a transaction. Jones is clearly capable of communicating individually between each and every device disclosed in whatever fashion the user would desire. Review for example, col. 4 lines 1-18 "The electronic purses **may take a number of physical forms...**Communication with the computer will generally be established by telephone and purses may be incorporated in telephones or modems....However a **more generally convenient arrangement is to have a portable purse such as an IC card which is loaded via modem connection either by a device specific to the individual.**" (Emphasis added)

Now, a modem should be considered old and well known as shown by either Nysen or Griffin. It stands to reason that any person who owned a computer or fax machine in the late 80's early 90's knew that when either of these devices was using the phone line that he could not make a phone call. That is, only one thing could be done over the dedicated line at a time. This appears to be the concept that applicant has obfuscated within the claim language. That is, the modem can only talk to either the smart card or the cash register, not both at the same time. Whether or not this provides security may be an added benefit but it is irrelevant. That is, it is considered old and well known that modem devices can only talk to one device at a time.

Again, this appears to be the same thing as being on line and then wanting to make a phone call, only one thing can be done at a time.

At the time of the invention it would have been obvious to one of ordinary skill in the art to have the pocket exchange device of Jones communicate directly with the bank accounting computers set forth in Fig 1. as well as the POS devices via a modem such that only one device at a time communicates with said bank accounting computer as taught to be an old and well known method of communication by modem by either Nysen or Griffin for the benefits of increasing the speed of the transaction, maintaining security, etc.

It is noted that the claim contains statements of *intended or desired use*. However, there is well settled case laws that such statements (adapted to) as to possible future acts or to what may happen in a method or operation, are essentially method limitations or statements of *intended or desired use* and do not serve to patentably distinguish the claimed structure over that of the references. See *In Re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus

from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2nd 1525, 1528

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

The Examiner has attempted to explain how the references read on the claim language. A review of prior Office actions appears to indicate that applicant is relying heavily upon the Examiners exact citations of columns and line numbers for the exact phraseology set forth in the claims instead of understanding the references teach as a whole. Jones sets forth the basic premise of applicant's invention as well as a plethora of variations that are considered to render applicant's invention obvious. There is no patentability is separating the various functions of the apparatus of Jones when the ultimate result is the same. In re Dulberg, 129 USPQ 348, (CCPA 1961) “It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.”

From the 12/10/2007 Non-Final Office action:

c. Applicant argues that Jones et al. does not set forth a switching circuit as claimed and that Griffin and Nysen et al. fail to disclose such. The Examiner has shown in the previous Office action how the references read on the claimed invention. It appears that the novelty presented by applicant is in combining an IC card reader and modem and the “switch” that prevents the IC card from being directly connected to the external information processor. However, Jones Col. 4 lines 1-15 disclose various manners of reading the IC card and the use of a modem. There is no novelty in merely rearranging the various parts of an already operating system. Resort may be had to case law to show this. See for example, In re Dulberg, 129 USPQ 348, (CCPA 1961) “It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art” and In re Wolfe, 116 USPQ 443, 444 (CCPA 1961)) “it would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable.” In this case it appears that applicant has merely moved the switch from the modem to the terminal unit.

d. Another way to look at this is to look at Figure 1 of the application as filed. Item 8 is a computer, Item 5 is an IC card reader and could stand alone, just

like a credit card reader at a store, a multiport external modem would contain the switch, modem and control unit to determine which connected item gets access through the modem. A modem does not connect its multiple external connections to each other (that would be a network card or hub) instead it connects it's devices to telephone lines or cable lines, etc. Again, only one item can talk at a time, so the modem multiplexes the info, but does not directly connect its external devices to each other.

e. Again, it has been held obvious to integrate various devices without presenting a patentable invention when the end result is predictable and results in the same outcome. Accordingly it is considered obvious to combine a modem with an IC card reader for the benefits thereof, multipurpose device, shared tasks, etc.

B. Applicant argues on page 11:

Furthermore, claim 27 has been amended to recite that the terminal device includes a power circuit having a storage battery which supplies a supply voltage to the data processor, the communication circuit, the switching circuit and the control circuit during at least transferring the money information from or to the IC card. None of the cited references disclose this feature.

B. Response:

Again **Apparatus claims cover what a device is, not what a device does.**

Applicant's amendment to claim 27 is nothing more than the intended use of the battery/power supply source "...**which supplies a supply voltage to** the data processor, the communication circuit, the switching circuit and the control circuit **during at least transferring the money information** from or to the IC card." (Emphasis added)

As already explained by the Examiner in said Final Office action it is immaterial WHERE the power comes from as long as power is available to the system. Rearranging where the power comes from does NOT present a patentably distinct invention:

Jones discloses applicant's invention as explained above. If applicant is of the opinion that Jones does not disclose what is considered obvious variants of

battery charging circuits then resort may be had to Prinsze to teach that such circuits are indeed old (more than thirty years) and well known.

As per claims 28-30 Jones teaches a value transfer system having a terminal device according to claim 27(Fig 1/5) as the user's input computer connected by a communication line to a host computer at a bank (col. 5 lines 41-42). Again if applicant is of the opinion that Jones fails to teach the system wherein said storage battery is charged through said communication circuit, an external power source and a selector between the two, then resort may be had to Prinsze.

Prinsze teaches in, for example, the abstract, Figures 1 and 2, col. 1 lines 15-21 and 31-35, col. 2 lines 33-50, claims 1-6, etc. that it is known in the art to supply appliances with rechargeable battery power for the benefits of, for example, ensuring the device will operate as desired with a maximum of convenience (i.e. not having to replace batteries). Prinsze also teaches that the charger should be able to utilize AC or DC sources. Although Prinsze is directed towards a flashlight, claims 1-6 are generic and the teachings of charging circuits as they have been applied to multiple devices since the 1970's cannot be overlooked.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Prinsze to the battery powered pocket exchange device of Jones to allow for the batteries in Jones to be charged by whatever means available including phone lines, solar power, external power sources etc., especially since the owner of the pocket exchange device (PED) would presumably be away from their home environment when shopping. That is, if the batteries of the PED go dead then the shopping experience is over since the IC card cannot be accessed by the PED. Which is also why Jones allows for the IC card to be removed from the PED and used in other embodiments, i.e. cash registers, POS devices etc.

Further resort may be had to Kuriyama to show that it is known in the Portable Terminal IC Card art to provide charging systems from various sources in order to keep the portable terminal compact and low in cost. See for example the abstract, col. 1 lines 49-63 etc.

Accordingly, at the time of the invention it would have been obvious to one of ordinary skill in the art to provide Jones with a method to charge the battery of the PED by any available manner to include the power from the phone lines, wall outlet, solar power etc. for the benefits of minimizing the size of the battery required by said PED as such is no more than the use of well known variants of supplying power.

Claim Rejections - 35 USC § 103

3. Claims 23-35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,623,547 to Jones et al (Jones) in view of either U.S. Patent 5,666,402 to Griffin or U.S. Patent 5,164,985 to Nysen et al. (Nysen) for the reasons set forth in section 5 of the previous Office action mailed 12/10/2007 which in turn refers back to section 9 of the previous office action mailed 5/2/2007.

The explanation in section 2A above is ALSO incorporated herein.

4. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claims 23-35 and 38 above in view of either U.S. Patent 4,092,580 to Prinsze and further or U.S. Patent 5,910,652 to Kuriyama for the reasons set forth in section 6 of the previous Office action mailed 12/10/2007 which in turn refers back to section 10 of the previous office action mailed 5/2/2007.

The explanation in section 2B above is ALSO incorporated herein.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2008-08-16

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694